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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,201	03/21/2001	Gerald Keith Sands	27600/M207A	2388
4743	7590	07/13/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			JAKETIC, BRYAN J	
6300 SEARS TOWER			ART UNIT	
233 S. WACKER DRIVE			PAPER NUMBER	
CHICAGO, IL 60606				

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/814,201

Applicant(s)

SANDS, GERALD KEITH

Examiner

Bryan Jaketic

Art Unit

3627

*mw*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beelitz et al in view of Ross (US 5,465,213) and Soehnlen et al. Beelitz et al disclose a method of fulfilling orders comprising the steps of receiving a first order from a first website server (see col. 3, lines 32-42) comprising a first product identifier and a first destination address (see col. 4, line 40 through col. 5, line 15); retrieving product content (see Figures 3); and assembling the product (see col. 17, line 62 through col. 18, line 4). It is inherent that Beelitz et al include the steps of packaging the product and addressing the mailer to the first destination address, and that Beelitz et al receives a second product order, retrieves second product content, and assembles, packages, and delivers the second product. Beelitz teaches that the product is ordered by a purchaser (see abstract). It is therefore inherent that the system of Beelitz receives payment information.

Beelitz et al do not teach that product being assembled is a book. Ross discloses a system for manufacturing a book upon request. Ross et al also teach the step of retrieving book content from a first or second database (20; see col. 6, lines 30-44). It is inherent that the first database may comprise the second database. Ross et al also teach that the book is printed by a digital printing press (107). It is inherent that the

books are printed chronologically. Ross et al further teach that the digital memory is structured to receive and decode a book identifier in the form of an ISBN (see col. 11, lines 2-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Ross with the invention of Beelitz et al to produce a book on demand through an Internet web site, because there is often a demand for a single copy of a book.

Beelitz et al do not teach the step of packaging the second book in a mailer including a second source identifier trademark that is visibly different from a first source identifier trademark. Soehnlén et al disclose a system for packaging products with different source identifiers, depending on the customer (see col. 1, lines 51-63 and col. 2, lines 63-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Soehnlén et al with the invention of Beelitz to employ different source identifiers depending on the source of the order to meet customer need.

Beelitz et al do not teach the step of receiving orders from different Internet domains. However, it is common in the art to receive orders from different Internet domains, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ this step with the invention of Beelitz because employing more sales channels increases sales.

Beelitz et al do not teach the step of printing invoices. However, invoices are common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ this step to provide customers with a receipt.

Beelitz et al do not teach the step of receiving payment information from the person living at the destination address or from information associated with a retail website. However, it is common in the art to receive payment information from both sources and it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive payment information from either source because both are convenient sources of the information.

Beelitz et al do not teach the step of assembling a second product before the second order is received. However, it is common in the art to assemble products and store them in inventory. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of assembling a second product before receiving a second order so that the future order may be processed more quickly.

Beelitz et al do not teach the use of an Ethernet receiver. However, Ethernet receivers are common in the art and it would have been obvious to employ an Ethernet receiver with the invention of Beelitz et al to facilitate the rapid transfer of information.

Beelitz et al do not teach the step of processing a personal credit card transaction. However, credit card transactions are common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of processing a personal credit card transaction with the invention of Beelitz et al for customer and merchant convenience.

***Response to Arguments***

3. Applicant's arguments filed 14 May 2004 have been fully considered but they are not persuasive. Applicant argues that Soehnlén is non-analogous art. Examiner respectfully disagrees. In the present application, the inventor's endeavor is fulfilling book orders by creating and packaging the ordered books. Soehnlén teaches a process of manufacturing and packaging ice cream. Examiner concedes that books and ice cream are different fields, but maintains that a method for packaging books would be analogous with methods for packaging any product. Both Soehnlén and the present application solve problems relating to the creation of packaging a product based on the specified consumer.

Applicant further argues that Beelitz does not teach the step of printing a book or using a printing press. Examiner concedes that Beelitz does not teach this step, and instead relies on Ross to supply this teaching. Ross et al also teach the step of retrieving book content from a first or second database (20; see col. 6, lines 30-44) and further teach that the book is printed by a digital printing press (107). Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Ross with the invention of Beelitz to print a book to fulfill a customer order.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bj

A handwritten signature in cursive script, appearing to read "John J. White".